

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed February 12, 2004 (the "Office Action"). At the time of the Office Action, Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38 were pending in this patent application and stand rejected. Applicants respectfully request reconsideration and favorable action in this case.

Double Patenting

The Examiner has indicated that Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38 conflict with Claims 1-32 of Application Serial No. 09/470,588. As noted in the previous response, Applicants will maintain a clear demarcation between the applications. Moreover, Applicants will file a terminal disclaimer when appropriate and necessary.

Claim Rejections – 35 U.S.C. §103

The Examiner rejects Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,791,991 to Small ("*Small*") in view of U.S. Patent No. 6,330,544 to Walker et al. ("*Walker*") and U.S. Patent No. 6,039,244 to Finsterwald ("*Finsterwald*"). Applicants respectfully submit that the claims, as presently presented, include numerous limitations not shown or suggested by the *Small*, *Walker*, or *Finsterwald*, whether taken alone or in combination. For example, Claim 1 recites:

1. A computer-based interface for facilitating rebate processing, the interface operable to:
 - display a plurality of product identifiers using the computer-based interface, wherein each of the product identifiers is associated with a product bearing a rebate;
 - receive purchase information from a user, wherein the purchase information identifies a purchased product associated with a selected one of the product identifiers;
 - receive a rebate request for a rebate on the purchased product, the rebate request having an associated rebate transaction identifier assigned by a remote rebate processing center;
 - retrieve status information for the rebate request from the remote rebate processing center using the rebate transaction identifier;
 - display the status information;
 - receive authorization of the rebate request;

display rebate information retrieved from the remote rebate processing center, the rebate information comprising at least two disbursement options determined based on the purchase information, a first one of the disbursement options having a first cash value to a recipient and a second one of the disbursement options having a second cash value to a recipient, the first cash value different than the second cash value; and
receive a selection of the disbursement options.

To sustain the rejection of Claim 1, the Office Action stitches together random excerpts from each of the three cited references. This violates basic requirements for sustaining any rejection. In addressing Applicants' claims, the claims must be considered as a whole. *See* M.P.E.P. § 2141 (stating that: "When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) The claimed invention must be considered as a whole . . ."). Applicants respectfully submit that the piecemeal reconstruction of Claim 1 is thus in contravention of established tenets of patent law. Also, Applicants respectfully submit that the cited portions of the references, upon examination, do not even teach or suggest the individual elements of Claim 1, let alone the claim elements when considered as a whole.

For example, consider the portion of Claim 1 requiring that the interface for rebate processing be capable of retrieving status information for a rebate request from a remote rebate processing center using a rebate transaction identifier. *Small*, the primary reference in this rejection, simply discloses a bingo game that can bring coupon and rebate information to the attention of a consumer. While *Small* mentions that rebate forms may be submitted for processing, *Small* fails to address any aspects of rebate processing that may take place following such a submission. Thus understandably, *Small* fails to mention providing any rebate status, let alone rebate status as required by Claim 1. As teaching for the rebate status elements, the Office Action points to *Walker* and *Finsterwald*, asserting that *Walker* can maintain a status field in a database and that:

Finsterwald discloses another similar rebate processing system in which that [sic] status of the rebate request is displayed to the user (col 10, lines 21-25). Therefore, it would have been obvious to one of skill in the art at the time the invention was made to notify the customer in Small of the current status of the rebate request, such as approved, denied, processing, etc.

Office Action, at page 7 (underline in original). However, upon review, it is clear that neither *Walker* nor *Finsterwald* teach or suggest anything like the rebate status of Claim 1. The status in *Walker* simply indicates whether a payment certificate has been “ISSUED” or “REDEEMED.” See, e.g., *Walker*, figure 5. In *Finsterwald*, the “status” that the Examiner cites to is simply the balance for a “point account” of a user that shows how many points the user has accumulated. *Finsterwald*, at column 10, lines 21-25. However, neither of these references teach or suggest an interface operable to “retrieve status information for the rebate request from the remote rebate processing center using the rebate transaction identifier,” as required by Claim 1.

Also, the aspects of the status retrieval elements of Claim 1 are intertwined with the other elements of Claim 1, such as “the rebate request,” “the remote rebate processing center,” and “the rebate transaction identifier.” For example, consider another specific requirement of Claim 1 that “the rebate request hav[e] an associated rebate transaction identifier assigned by a remote rebate processing center.” Not only do the references fail to teach these elements, but the Examiner’s use of unrelated excerpts from the three cited references fails to account for the interrelated nature and full meaning of these claim terms when Claim 1 is considered as a whole.

Thus Applicants respectfully submit that the piece by piece reconstruction of Applicants’ Claim 1 using, in many instances, unrelated portions of three very different references is improper in light of the basic tenets of patent law. Also, even ignoring the impermissible assembly of random excerpts, Applicants respectfully submit that the cited references fail to show all of the elements of Claim 1.

For substantially the same reasons discussed above, Applicants respectfully submit that the *Small-Walker-Finsterwald* combination, as applied to independent Claims 11, 21, and 31, is similarly inappropriate and insufficient to show obviousness. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw the rejection to Claims 1, 11, 21, and 31 and their respective dependent claims based upon the *Small-Walker-Finsterwald* combination.

Moreover, Claim 31 includes various different limitations that are also patentably distinct from the teachings of the *Small*, *Walker*, and *Finsterwald*. Claim 31 recites:

31. A method for processing a rebate, comprising:
- receiving purchase information identifying a product bearing a rebate;
 - communicating the purchase information to a remote rebate processing center using an electronic communications network;
 - receiving rebate information describing the rebate from the remote rebate processing center, the rebate information comprising at least two disbursement options, a first one of the disbursement options having a first cash value to a recipient and a second one of the disbursement options having a second cash value to a recipient, the first cash value different than the second cash value; and
 - displaying the rebate information;
 - receiving consumer information from the user, wherein the consumer information identifies a purchase of the product bearing the rebate;
 - communicating the consumer information to the remote rebate processing center to initiate a rebate request;
 - receiving a rebate transaction identifier from the remote rebate processing center, the rebate transaction identifier assigned to the rebate request by the remote rebate processing center;
 - outputting the rebate transaction identifier for physical delivery to the remote rebate processing center;
 - retrieving status information for the rebate request from the remote rebate processing center using the rebate transaction identifier; and
 - displaying the status information.

In dismissing all of the independent claims together, the Examiner fails to address elements of Claim 31 such as “receiving a rebate transaction identifier from the remote rebate processing center, the rebate transaction identifier assigned to the rebate request by the remote rebate processing center” or “outputting the rebate transaction identifier for physical delivery to the remote rebate processing center.” Applicants respectfully submit that the *Small-Walker-Finsterwald* combination fails to teach or suggest these and other elements of this claim. Therefore, Applicants again respectfully request the Examiner to reconsider and withdraw the rejection to Claim 31 and its respective dependent claims.

Conclusions

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

The Commissioner is hereby authorized to charge any other fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
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